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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,767	04/05/2007	Thorsten Krawinkel	101769-362-WCG	3925
27386 7590 01/26/2010 GERSTENZANG, WILLIAM C. NORRIS MCLAUGHLIN & MARCUS, PA 875 THIRD AVE, 8TH FLOOR NEW YORK, NY 10022				
EXAMINER				
LENIHAN, JEFFREY S				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
01/26/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/581,767

Applicant(s)

KRAWINKEL, THORSTEN

Examiner

Jeffrey Lenihan

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is responsive to the amendment filed on 11/24/2009.
2. The objections and rejections not addressed below are deemed withdrawn.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 103

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groves, US5623010 (of record) in view of supporting evidence disclosed in DuPont Technical Data Sheet, TYZOR Technical Bulletin K-17591 (of record).

The rejection stands as per the reasons outlined in the previous Office Action, incorporated herein by reference.

5. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groves, US5623010 (of record), in view of Graham, US4005247 (of record).

The rejection stands as per the reasons outlined in the previous Office Action, incorporated herein by reference.

Response to Arguments

6. Applicant's arguments filed 11/24/2009 have been fully considered but they are not persuasive.

7. Regarding the rejection of claims over Groves in view of the supporting evidence presented in TYZOR Technical Bulletin K-17591: Independent claim 1 has been amended to require that the claimed composition comprises no acrylate-containing polyolefins; applicant argues that this limitation distinguishes the claimed composition from the compositions disclosed in Examples 1-7 of Groves, each of which contains an acrylic copolymer. The examiner notes that the accepted definition of an "olefin," as reported by the International Union for Pure and Applied Chemistry (IUPAC), is an acyclic or cyclic hydrocarbon having one or more carbon-carbon double bonds apart from those bonds in an aromatic ring (see the attached olefin definition printed from the IUPAC webpage). The term "hydrocarbon" is used in the art of chemistry to refer to chemicals which are made only from carbon and hydrogen. The acrylic copolymer of Examples 1-7 of Groves is a copolymer of iso-octyl acrylate and acrylic acid (Column 10, lines 30-44), both of which contain oxygen and therefore are not hydrocarbons. The acrylic copolymer in the examples of Groves does not comprise any monomers that meet the definition of an "olefin" and therefore is not an acrylate-containing polyolefin; thus, the presence of the acrylic copolymer disclosed in Examples 1-7 of Groves is not excluded by the limitation that the claimed composition does not comprise an acrylate-containing polyolefin.

8. Applicant states that TIZOR is used to cross-link through functional groups such as -OH, -COOH, etc., and states that "[A]pplicant's vinyl aromatic block copolymers do not have any of such functional groups" (see remarks page 6, lines 1-2). The examiner is unclear what applicant is attempting to argue, as the specification clearly teaches that

at least some of the vinyl aromatic block copolymer must be acid- or acid anhydride-modified, and discloses the use of compounds such as fumaric acid and acrylic acid to perform said modification (Spec. Page 6, lines 1-7). Modification with either of these two compounds would introduce a -COOH group to the vinyl aromatic block copolymer.

9. In the event that applicant intended to argue that Groves does not teach a vinyl aromatic block copolymer having such groups, the examiner notes that -COOH groups will inherently be present. As discussed in the previous Office Action, the compositions disclosed in Examples 1-7 of Groves comprise a styrene-ethylene/butylene-styrene block copolymer (SEBS) having bound succinic anhydride groups; this polymer dissolved in a solvent mixture comprising ethanol (Column 10, lines 27-29). It is known in the art of chemistry that acid anhydrides react readily with alcohols (see the attached excerpt from Ege); at least some of the bound succinic anhydride groups will therefore react with the ethanol; resulting in the opening of the anhydride ring and the formation of a -COOH group. As TIZOR is known to cross-link polymers through -COOH groups, the examiner takes the position that at least a portion of the succinic anhydride-modified SEBS in the compositions of Groves will be cross-linked via reaction with the TIZOR additive. Applicant is therefore required to provide factual evidence demonstrating that the limitation of a cross-linked vinyl aromatic block copolymer is not inherently met by the prior art.

10. Regarding the limitation of being detachable by stretching in the bondline direction; it has been held that a chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the

properties applicant discloses and/or claims are necessarily present; see *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). It is reasonably believed that this limitation is inherently met by the disclosure of the prior art because the disclosed adhesive film comprises the same components as the claimed invention: a cross-linked, acid anhydride-modified vinyl aromatic block copolymer, a tackifier resin, and a metal chelate corresponding to the claimed formula. Applicant is therefore required to provide factual evidence demonstrating that the limitation used to define the claimed invention is not inherently met by the composition rendered obvious by the prior art.

11. Regarding the rejection of claims over the combination of Groves in view of Graham: Arguments regarding the disclosure of Groves are discussed above. Regarding the cross-linking of the vinyl aromatic component, Graham teaches that the metal chelate reacts through acid anhydride groups. As noted above, the compositions in Examples 1-7 of Groves comprise a succinic anhydride-modified SEBS. As the metal chelate of Graham is reported to be reactive towards acid anhydride functionalities, It is reasonably believed that the limitation of a cross-linked vinyl aromatic block copolymer is inherently met by the composition rendered obvious by the prior art, as at least a portion of the acid anhydride functional groups present in the succinic anhydride-modified SEBS of Groves will react with the metal chelate. Applicant is therefore required to provide factual evidence demonstrating that the limitation of a cross-linked vinyl aromatic block copolymer is not inherently met by the composition rendered obvious by the prior art.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Lenihan whose telephone number is (571)270-5452. The examiner can normally be reached on Monday through Thursday from 7:30-5:00 PM, and on alternate Fridays from 7:30-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/
Primary Examiner, Art Unit 1796

/Jeffrey Lenihan/
Examiner, Art Unit 1796

/JL/